

Hearing:
May 14, 1998

Paper No.32
RFC

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB MARCH 23, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

CompuServe, Inc.
v.
Online Careline, Inc.

Opposition No. 98,117
to application Serial No. 74/466,629
filed on December 3, 1993

Gail L. Morrissey of Standley & Gilcrest for Compuserve,
Inc.

L. Dan Tucker of Locke Purnell Rain Harrell for Online
Careline, Inc.

Before Cissel, Hohein and Hairston, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On December 3, 1993, applicant applied to register the
mark "ON-LINE TODAY" on the Principal Register for "services
in the nature of interactive electronic communication of
information, including providing interactive advice and
counseling via computer usage over telephone lines," in
Class 38. The recitation-of-services clause was later
amended to state the services as "services in the nature of

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interactive electronic communication of information, namely providing information in the fields of financial, news, sports, weather and general information and in providing round table discussions whereby users communicate their opinions on topics and in providing Internet access," in Class 42. The term "ON-LINE" was disclaimed apart from the mark as shown. On February 20, 1997, the parties to this opposition stipulated to an amendment of the application to recite applicant's services as simply "providing telecommunication connections to a global computer network," in Class 38.

The basis for filing the application was applicant's assertion that it possessed the bona fide intention to use the mark in connection with the rendering of the specified services in commerce, although applicant did commence use of the mark subsequent to the filing date of the application.

Following publication of the mark in the Official Gazette, a timely Notice of Opposition was filed by CompuServe, Inc. on July 21, 1995. As grounds for opposing registration of applicant's mark, opposer pleaded that it had, since long before the filing of the opposed application, continuously used the mark "ONLINE TODAY" in connection with "the marketing of computer programs and computerized communication services including providing access to on-line computer services offering computer

enhanced news and commentary"; that these services are closely related to the services specified in the opposed application; and that applicant's mark, as used in connection with the specified services, so resembles opposer's mark that confusion is likely.

Applicant's answer denied the essential allegations of opposer and asserted as an "affirmative defense" that applicant had, without knowledge of opposer's mark, adopted and begun using "ON-LINE TODAY" as a mark for "services in the nature of interactive electronic communication of information from a time prior to the earliest date of actual use of opposer's mark..." This claim was not proved, or even argued, for that matter, however, so applicant has not established any basis for the Board to rule in its favor because of this "defense."

A trial was conducted in accordance with the Trademark Rules of Practice, and both parties filed briefs. An oral hearing before the Board was conducted on May 14, 1998.

The record in this proceeding includes the following: applicant's answers to certain of opposer's interrogatories; opposer's answers to certain of applicant's interrogatories; the trial testimony (with exhibits) of Douglas Branstetter, opposer's Manager of Multimedia Products, made of record by opposer; the discovery deposition of Mr. Branstetter (also with exhibits), made of record by applicant's notice of

reliance; the trial testimony (including exhibits) of Courtney Wang, applicant's president; and other documentary evidence made of record by applicant's notice of reliance.

The issues for our resolution are whether opposer has priority, and whether applicant's mark, when it is used¹ in connection with the services presently set forth in the application, so resembles opposer's mark, as used in connection with opposer's services, that confusion is likely.

Based on careful consideration of the record and the applicable legal principles and authorities, we conclude that opposer has priority and that confusion is likely.

The recitation of services in the opposed application, as amended, refers to "providing telecommunications connections to a global computer network." This amendment is accepted because it represents a limitation of the previous recitation by striking the references to interactive communication and providing information in various fields, and it simply restates the service of "providing Internet access" with the reference to providing telecommunications connections to a global computer network.

¹ The testimony of Mr. Wang establishes that applicant began use of its mark in promotional materials in 1993; that applicant signed up its first customer in early 1995; and that applicant actually uses the mark in the form "Online Today," rather than in the hyphenated form shown in the drawing submitted with the application. However, it is the hyphenated form shown in the drawing which must be considered in determining whether there is a likelihood of confusion in this case.

According to Mr. Wang, applicant's only activity is providing individual personal computer users or end users with direct access to the Internet. Applicant was founded in 1992, and first rendered this service in 1995.

Opposer also provides Internet access, although not under the mark "ONLINE TODAY." Opposer's main business is consumer online products and services. It's "flagship" service is "CompuServe Information Service," which offers Internet access, online information, travel services, banking, shopping features, news, informational features, chat and e-mail functions.

In 1983, opposer began using the mark "Online Today" as the name of a printed magazine. The magazine provided news, software and hardware reviews, computer industry news, new product announcements and other information and advertising related to computers. In 1984, opposer began producing an electronic version of the magazine. The printed version and the electronic version coexisted until 1990. From then on, the mark "CompuServe" was used on the printed version of the magazine, but the mark "Online Today" has remained in use in connection with the electronic version. Mr. Branstetter characterized "Online Today" as "an online counterpart to CompuServe Magazine, an electronic news service that was a companion to CompuServe Magazine." (p. 9 of his June 19, 1996 testimony). Later in the same deposition, at p. 39, he

called "Online Today" "an information feature—news feature" of the information service opposer provides.

Ordinary consumers who have personal computers purchase both Internet access services and online services. The fact that opposer renders both of these services shows that prospective purchasers have reason to expect both to be available from a single source. Applicant's own witness, its president, Mr. Wang, testified (at p. 36) that a user of a personal computer could subscribe to both applicant's "ONLINE TODAY" Internet access service and opposer's online information service, which features opposer's "Online Today" magazine about computer products and services.

Under these circumstances, confusion is likely. The marks are virtually identical, and the services, while not exactly the same, are nonetheless closely related and have been shown to be available from a single source.

Applicant argues that confusion would not be likely because the purchasers of these kinds of services are knowledgeable and sophisticated, and therefore know with whom they are dealing. As we noted above, however, the market for these kinds of services, both Internet access and "content" or information services provided by means of computers, is ordinary people who own and/or operate personal computers. With the broad proliferation of computers into homes, schools and places of business, such

customers increasingly are not necessarily or particularly knowledgeable or sophisticated. When applicant's argument that confusion is not likely because such customers know with whom are dealing is boiled down, it amounts to contending that the marks of the parties do not matter, that buyers will keep the parties straight anyway. We cannot adopt this conclusion without clear proof.

The fact that the only people who encounter opposer's "Online Today" electronic magazine are subscribers to opposer's "CompuServe" information services is not determinative. The number of such subscribers is not insignificant, amounting to hundreds of thousands of people. These individuals all are potential purchasers of applicant's Internet access services.

That this record does not contain evidence that actual confusion has occurred does not mandate a different result. The test is whether confusion is likely, not whether it has occurred. *Gillette Canada Inc. v. Ranir*, 23 USPQ2d 1768 (TTAB 1992).

For the reasons set forth above, the opposition is sustained, and registration of applicant's mark is refused.

R. F. Cissel

G. D. Hohein

P. T. Hairston
Administrative Trademark Judges
Trademark Trial and Appeal Board